

Paper No. 11

BAC

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB

JAN. 25, 99

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Carroll Company

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Serial No. 75/102,948

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Harold E. Meier of Gardere & Wynne, L.L.P. for Carroll  
Company

Ronald McMorrow, Trademark Examining Attorney, Law Office  
105 (Thomas G. Howell, Managing Attorney)

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Before Hanak, Walters and Chapman, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Carroll Company (applicant) has appealed from the  
final refusal of the Examining Attorney to register the  
mark BRITE BOY for "liquid metal polish" in Class 3.<sup>1</sup> The  
Examining Attorney has refused registration under Section  
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the basis

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<sup>1</sup> Application Serial No. 75/102,948, filed May 13, 1996. The  
claimed dates of first use and first use in commerce are May 20,  
1986.

of Registration No. 1,623,195, issued November 20, 1990,<sup>2</sup>  
for the mark shown below



for "blocks and sticks made of abrasive impregnated rubber compound adopted for metal polishing and cleaning operations" in Class 3, and "discs and wheels for polishing and grinding machines" in Class 7.

Briefs have been filed, but an oral hearing was not requested.

Essentially, the Examining Attorney argues that the marks are identical in sound, and similar in appearance, meaning and connotation; that both applicant and the registrant provide goods used to polish metal; and that both identifications of goods are unrestricted, thus, the goods must be presumed to travel in all normal channels of trade.

Applicant, on the other hand, argues that when considered in their entirety, the marks are different in appearance as applicant's mark consists of two words, with

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<sup>2</sup> Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce for both classes are 1971; with claimed first use in another form for both classes of July 1918.

BRITE spelled one way, whereas registrant's mark is one word, with a different spelling of BRIGHT, and including a design feature<sup>3</sup>; that the goods are unrelated because the registrant's goods are tools or tool attachments for machines and blocks and sticks which contain abrasive elements intended to abrade the surface, while applicant's liquid metal polish contains no abrasives and is intended to clean but not abrade the metal surface; and that applicant's "product is sold extensively for polishing brass and chrome on large boats" (Applicant's brief, p. 3), and if the metal polish abraded the surface it would damage the hardware and be unacceptable for its intended use.

Applicant also contends that the channels of trade and purchasers are separate as the registrant's goods are sold "through specialized distribution channels that handle abrasive industrial products" (Applicant's brief, p. 4), but applicant's goods are sold to distributors and in retail stores; that purchasers of specialized tools such as registrant's "are likely to be more careful and sophisticated than the average consumer because of the specialized nature of the goods" (Applicant's brief, p. 4);

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<sup>3</sup> In applicant's April 21, 1997 response to the first Office action, applicant stated that the marks "are similar" (Applicant's response, p. 2). But in its brief on the case applicant argued that the marks are not similar.

and that applicant is unaware of any instance of actual confusion in the ten years of use of their respective marks by applicant and registrant.

In response, the Examining Attorney contends that there is no limitation with respect to the intended uses of applicant's goods, nor the channels of trade through which applicant's goods may be sold; and that a lack of actual confusion is not the test in determining likelihood of confusion.

With respect to the goods, we must consider both classes of goods in the cited registration vis-à-vis applicant's goods. As to registrant's "discs and wheels for polishing and grinding machines", we agree with applicant that these goods are unrelated to applicant's "liquid metal polish". The Examining Attorney made of record six third-party registrations which indicate that entities have registered a single mark for both metal polish and machines used for polishing. However, registrant's discs and wheels are attachments for polishing machines, not the machines themselves. We find that the registrant's goods, discs and wheels intended for attachment to polishing and grinding machines, are not sufficiently related to applicant's liquid metal polish to

result in confusion, even if sold under the same or similar marks.

However, with regard to the other category of goods, we find that applicant's liquid metal polish and registrant's blocks and sticks made of abrasive impregnated rubber compound adopted for metal polishing and cleaning are related goods. Applicant submitted advertisements showing that applicant's goods do not contain abrasives, a copy of applicant's own company brochure, a photograph showing applicant's goods on a retail store shelf, and Internet information regarding registrant's goods<sup>4</sup>. Of course, goods need not be identical or even competitive to support a finding of likelihood of confusion; it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978); and *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992). Although these goods are

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<sup>4</sup> The Examining Attorney incorrectly asserted that applicant's evidence was untimely because it was submitted with applicant's appeal brief. Applicant had originally submitted all of the exhibits with its August 8, 1997 request for reconsideration, which the Examining Attorney considered and denied.

not identical, they are nonetheless both metal polish (in stick and block or liquid form).

Further, the Board must determine the issue of likelihood of confusion on the basis of the goods as identified in the application and the registration, and absent a restriction in the identification of goods, the Board must presume that the goods move through all of the normal channels of trade for goods of this type. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

In this case applicant contends that the cited registration goods (sticks and blocks made of abrasive compound for metal polishing and cleaning) are sold only through specialized distribution channels and are for industrial uses, and that applicant's own goods (liquid metal polish) are for use on chrome and brass hardware on large boats. In fact, these are restrictions referred to by applicant, but neither identification of goods is so restricted. That is, both identifications of goods are broad as they relate to metal polish.

We acknowledge that the identifications of goods show registrant's metal polish is in the form of sticks and

blocks and that it contains abrasives, whereas applicant's metal polish is in liquid form. (Also, we note that applicant's advertisements refer to the fact that there are no abrasives in applicant's product.) However, despite these minor differences in the goods, purchasers are likely to believe nonetheless that these goods come from the same source, if sold under the same or similar marks. Thus, we find that registrant's sticks and blocks for metal polishing and applicant's liquid metal polish are related.

Turning to the marks, we find there is a strong similarity between the marks. Applicant's mark is identical in sound to the cited registrant's mark. Different spellings for BRITE and BRIGHT, and the use of one word or two does not affect the identity of the spoken marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255, 259 (TTAB 1980). Applicant's mark, BRITE BOY, is simply the changed spelling of the registrant's mark, BRIGHTBOY.

As to appearance, while there are clearly differences in these respective marks (both marks use different spellings of the word BRITE/BRIGHT, and one has a design feature), it is not improper to give more weight to a dominant feature of a mark. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); *In re*

Electrolyte Laboratories Inc., 913 F.2d 930, 16 USPQ2d 1239 (Fed. Cir. 1990); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553 (TTAB 1987). The word BRIGHTBOY is the dominant portion of the cited mark, and BRITE BOY is applicant's entire mark. Thus, the common, dominant element in these two marks are the words. Moreover, generally the word portion of a mark, i.e., the portion utilized in calling for the goods, is most likely to be impressed in the purchaser's memory and to serve as the indicium of origin. See Consumers Building Marts, Inc. v. Mr. Panel, Inc., 196 USPQ 510 (TTAB 1977). That is, the differences are not likely to be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467 (TTAB 1988); and Edison Brothers Stores v. Brutting E.B. Sport-International, 230 USPQ 530 (TTAB 1986).



Both marks, BRITE BOY and BRIGHTBOY, in the context of the goods, convey the same connotation that the metal polish will result in brightness when it is applied to various metal surfaces.<sup>5</sup>

According to applicant, there have been no instances of actual confusion. However, the test is likelihood of confusion, not actual confusion.

We conclude that consumers familiar with registrant's sticks and blocks for metal polishing and cleaning sold under the mark BRIGHTBOY and design would be likely to believe, upon encountering applicant's mark, BRITE BOY, for liquid metal polish, that the goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The refusal of registration is affirmed only as to the Class 3 goods in the cited registration.

E. W. Hanak

C. E. Walters

B. A. Chapman  
Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board

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<sup>5</sup> The Examining Attorney submitted Webster's II New Riverside University Dictionary definition of the word "polish" as "1. to make smooth and shiny by rubbing or chemical action."